

### REMARKS

Claim 1 has been amended and Claims 3, 4, and 43-50 have been cancelled without prejudice. As a result, Claims 1, 6-9, 12, 13, and 15-17 remain pending in the present application. Support for the amendments is found in the specification and claims as filed. Accordingly, the amendments do not constitute the addition of new matter. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

#### Rejection under 35 U.S.C. § 102

The Examiner rejected Claims 1, 3, 4, 6, 9, 12, 13, and 15 under 35 U.S.C. § 102(b) as being anticipated by Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, or Grant '865. The Examiner also rejected Claims 1, 3, 4, 6-9, 12, 13, and 15-17 under 35 U.S.C. § 102(e) as being anticipated by Bavisotto et al. Each of these references teaches that a composition comprising a CO<sub>2</sub> extract of hops is used in a food. Ogasahara et al. teaches a method for producing hops extract which would be useful in the production of beer. Millis et al. teaches the use of beta acids as extracted from hops for controlling *Listeria* and other food pathogens in food products. With regards to hops, Spinelli et al. teaches that supercritical carbon dioxide can be used in extraction of the essence of hops for use in the brewing of beer. Thiele et al. teaches a process for the preparation of bitter tasting beverages. Both Grant '561 and Grant '865 teach a method of processing hops or hop extracts for brewing. Bavisotto et al. teaches a preparation of a fermented malt champagne.

According to M.P.E.P. 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

As amended, Claim 1 recites, *inter alia*, a composition in a form selected from the group consisting of capsule, tablet, injectable solution, injectable suspension, spray solution, spray suspension, and lotion. None of Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, or Bavisotto et al. discloses a composition comprising a CO<sub>2</sub> extract of hops in

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the forms as recited in Claim 1. Therefore, Claim 1 is not anticipated by Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, or Bavisotto et al.

The Examiner rejected Claims 1, 3, 4, 6-9, 12, 13, and 15-17 under 35 U.S.C. § 102(e) as being anticipated by Newmark et al. Newmark et al. has a filing date of April 5, 2001.

According to M.P.E.P. 706.02(b), a rejection based on 35 U.S.C. § 102(e) can be overcome by filing an affidavit or declaration under 37 C.F.R. § 1.131 showing prior invention, if the reference is not a U.S. patent (or application in the case of a provisional rejection) claiming the same patentable invention.

Submitted with this Amendment is a Declaration under 37 C.F.R. § 1.131 by the inventors showing prior invention. In Exhibit A of the Declaration under 37 C.F.R. § 1.131, there is a draft of a patent application dated before April 5, 2001 that discloses features as recited in the pending claims. The Declaration states that the inventors conceived the subject matter of all the pending claims, as presently amended, of the present application and were diligently working on experiments to actually reduce the claimed invention to practice and constructively reduce the invention to practice by filing the present patent application. Since the inventors of the present application have evidence of conception of the subject matter of the pending claims and diligence of reduction to practice, the inventors are entitled to an invention date prior to the filing date to Newmark et al. Therefore, the pending claims are patentable over Newmark et al.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 102.

#### Rejection under 35 U.S.C. § 103

The Examiner rejected Claims 1, 2, 3, 6-9, 12, 13, and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, or Bavisotto et al. in view of Haas, Verluys, and Todd Jr. Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, and Bavisotto et al. have been summarized above. Haas teaches an oral preparation having the effect of inhibiting dental caries

in the mouth. Haas does not disclose the oral preparation in a form as recited in Claim 1. Todd, Jr. teaches a beer flavored with a non-acidic hop-flavor fraction.

According to the Examiner, it would have been obvious to add vitamins and carbohydrates and the like to the compositions of the primary references since Haas and Todd make it clear that such hop extracts routinely have sweeteners and vitamins in them, especially if they are used in a food.

The Examiner rejected Claims 1, 2, 3, 6-9, 12, 13, and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Haas in view of Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, or Bavisotto et al. in further view of Verluys and Todd Jr. Verluys teaches a method of preserving hops from oxidation by adding ascorbic acid to the hops.

According to the Examiner, it would have been obvious to use a CO<sub>2</sub> extract of hops in Haas since Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, or Bavisotto et al. all make it clear that CO<sub>2</sub> extraction of hops is well known in the art and is commonly used.

According to M.P.E.P. 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

As stated above, Claim 1 recites, *inter alia*, a composition in a form selected from the group consisting of capsule, tablet, injectable solution, injectable suspension, spray solution, spray suspension, and lotion. None of Ogasahara et al., Millis et al., Spinelli et al., Thiele et al., Grant '561, Grant '865, Bavisotto et al., Haas, Todd, Jr., or Verluys et al. disclose or suggest a composition comprising a CO<sub>2</sub> extract of hops in the forms as recited in Claim 1. Since the recited prior art discloses compositions in the form of food, it is not readily obvious to one skilled in the art to add hops extract to a form as recited in Claim 1. The area of additives to food is different from the area of additives to the forms as recited in Claim 1. Since none of the recited prior art references teach or suggest all the claim limitations, Claim 1 is patentable over the recited prior art.

Accordingly, Applicants respectfully request the Examiner withdraw the rejections under 35 U.S.C. § 103(a).

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CONCLUSION


In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned in order to resolve such issue promptly.

Respectfully submitted,

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Dated: June 9, 2003

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CCT-4300.DOC:cb060603